

REMARKS

With entry of the present amendment the application will contain claims 11-22, 24 and 25.

Double Patenting

The Examiner is thanked for pointing out the possibility of a double patenting rejection in the future. If such rejection is made, rights are reserved to show the difference between the allowed claims in this case and the allowed claims in any other issued patent. Furthermore, all rights are reserved to the filing of a terminal disclaimer.

Issues Under 35 USC 103

The rejection of claims 11-22 as obvious over US patent 5,632,676 (Kurschner) in view of US patent 6,165,964 (Takahashi) and US patent 6,352,727 (Nishimoto) is traversed on the grounds that it would not be obvious to combine the references in the manner suggested by the Examiner in order to arrive at the claimed method.

Kurschner discloses a method for sanitizing fowl that has been killed, plucked and eviscerated, using peracetic acid solution (see Abstract and claim 1). Nishimoto is directed to using an aqueous antibacterial solution of hinokitiol for purposes of disinfecting,

wherein such disinfecting can be conducted in food factories. The Examiner argues that since hinokitiol is a disinfectant in a food factory that it is obvious to use it on food. The contrary is true.

First, Nishimoto does not disclose that a hinokitiol solution can be applied to food. Nishimoto '964 specifically discloses:

The antimicrobial agent or microbicide of the present invention comprises the above-mentioned aqueous solution of essential oil from plants. The antimicrobial agent or microbicide of the present invention is useful, because they exhibit broad antimicrobial spectrum to many kinds of microbials and do not generate resistant strain to them. For example, the antimicrobial agent and/or microbicide can be widely used for kitchen goods such as a kitchen towel, a cutting board, and knives; filters for an air conditioner, air cleaner and electric cleaner; and medical devices such as an inhalator, and a humidifier. Therefore, the antimicrobial agent or microbicide of the present invention is widely used in hospitals or food factories. (See Col. 8, line 61 to Col. 9, line 6).

Here, there is no disclosure of using an antimicrobial agent for food. Thus, one of ordinary skill in the art would not refer to Nishimoto or be motivated in combining this reference with Kurschner upon reading Kurschner. U.S. case law holds that there are three possible sources of motivation to combine references: the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Here, the requisite motivation is lacking since one of

ordinary skill in the art would not refer to Nishimoto because this secondary reference is directed to a different sterilization agent than that of Kurschner. The nature of the problem, teachings, etc. are different in Nishimoto than in Kurschner.

Second, even if a sterilizing agent is used to sterilize some goods or devices in factories (as disclosed by Nishimoto), one of ordinary skill in the art does not equate such disclosure as sterilization of food. Instead, one of ordinary skill in the art recognizes that great care is exercised when using sterilizing compositions for food due to any potential compromises in safety to health. Further, great care must also be considered by one of ordinary skill in the art due to other problems, such as any influences in the color of the food to be sterilized, the effects on the flavor of the food, etc.

Kurschner even depicts the problems that one of ordinary skill in the art encounters when sterilizing food. Specifically, Kurschner refers to the bloated appearance, changes in texture, and the discoloration in poultry meat caused by various sterilization methods (see Col. 1, lines 39-56). As an example, the method using peracetic acid cannot be in direct contact with fowl, "perhaps because of an adverse experience with hydrogen peroxide" (Col. 1, lines 54-56). Thus, in view of the considerable problems involved in sterilizing food, one of ordinary skill in the art would not

equate disinfecting compositions for kitchen goods and filters with sterilization compositions for food. In other words, one of ordinary skill in the art would not consider applying hinokitinol, of which use is yet unknown, in sterilizing food.

Third, no scientific evidence has been presented to show that sterilization methods to disinfect medical equipment or factories are equivalent to sterilization methods to disinfect food. The Examiner merely argues that it would be obvious to add one component of Nishimoto to the Kurschner composition without any regard to the scientific implications or what one of ordinary skill in the art actually considers when reading the cited references.

Fourth, Nishimoto is in a non-analogous art from that of Kurschner. The attention of the Examiner is respectfully invited to *In re Oetiker* 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the appellant argued that the Examiner improperly used non-analogous art as a basis for an obviousness rejection. The Examiner in *Oetiker* did not reason with what the cited reference disclosed, but instead stated that a person faced with the particular problem at hand would look to the non-analogous art (the cited reference) because the non-analogous art would solve the same problem that the present invention solved.

The deficiencies of Kurschner and Nishimoto, as discussed above, are not supplied by US Patent 6,352,727 (Takahashi).

The Examiner asserts that "Takahashi teaches that hinokitiol cannot only be used to treat meat processing equipment but can also be used to treat the meat itself (column 7, lines 30-55)", and that "it would have been obvious to one of ordinary skill in the art at the time the invention was made by modifying the antibacterial solution of Kurschner et al. by substituting the antibacterial solution hinokitiol as taught by Nishimoto et al. to sterilize poultry meat during processing."

However, Takahashi describes a bactericide or a fungicide comprising a polar solvent extract of leaves of eucalyptus plants and chitosan (see, ABSTRACT), and the bactericide or the fungicide does not basically contain hinokitiol. Hinokitiol is one of other bactericides (or fungicides) together with which the bactericide (and the fungicide) can be used to enhance bactericidal (or fungicidal) effect (column 6, lines 26 to 29, and column 7, lines 4 to 8).

Specifically, Takahashi neither discloses nor suggests that sterilization of poultry meat during processing can be carried out by hinokitiol itself.

On the other hand, the present invention provides a method of sterilizing poultry meat comprising sterilizing poultry meat with an aqueous hinokitiol solution consisting essentially of hinokitiol and water. As discussed in the specification, other non-toxic

materials can also be included in the claimed solution. Such a constitution of the present invention is neither disclosed nor suggested in Kurschner et al. and Nishimoto et al., or even in Takahashi. Also, the effects exhibited by the present invention cannot be expected from these references. Therefore, even if Takahashi were added to Kurschner et al. and Nishimoto et al., one of ordinary skill in the art cannot easily arrive at the present invention.

Therefore, the present invention is not obvious in view of these references.

CONCLUSION

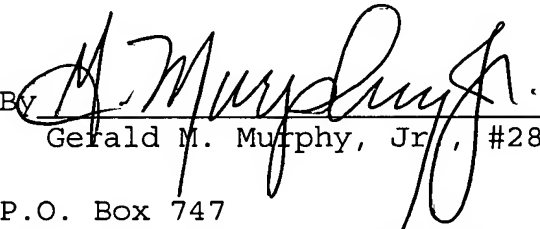
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Appl. No. 10/006,569

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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